REMARKS

Reconsideration and withdrawal of the rejection and the allowance of all claims now pending in the above-identified patent application (*i.e.*, Claims 20-27) are respectfully requested in view of the foregoing amendments and the following remarks.

At the outset, it should be recognized that the present invention, as now claimed, broadly discloses a method for playing a collateral wagering game in combination with a standard wagering game, which includes the steps of:

making a wager by a player for participating in a standard wagering game;

making, for example, an additional wager by the player on an outcome of the standard wagering game, the additional wager (or other optional means) by the player being optional for allowing the player to also participate in the collateral wagering game;

determining whether the outcome of the standard wagering game comprises a winning outcome for the player, wherein a prize amount for the standard wagering game is determined when the winning outcome is achieved in the standard wagering game, the player being capable of having the winning outcome in the standard wagering game and receiving the prize amount for the standard wagering game without having to place said additional wager (or exercising other optional means) for participating in the collateral wagering game;

allocating a prize value to the collateral wagering game based upon the winning outcome in the standard wagering game;

determining a total prize value for the player in the collateral wagering game when the player has made said additional wager (or exercised other optional means) for participating in the collateral wagering game; and,

paying the player the prize amount, as determined in the standard wagering game and the total prize value for the collateral wagering game, to which the player is entitled to receive.

The player of the standard (or base) game of the claimed method has the option of playing the collateral wagering game, by choosing, *e.g.*, to make an additional wager, however, a refusal to make the additional wager (and thereby not participate in the collateral game) does not prevent the player from receiving a prize amount for having a winning outcome in the standard game. Instead of using "an additional wager" for permitting players to exercise the option of playing the collateral game, the game operator may choose other means for allowing players to indicate their desire for participating in the collateral game.

As will be explained in greater detail hereinafter, nowhere in the prior art is such a novel method for playing a standard wagering game, in combination with an optional collateral wagering game, disclosed or suggested.

By the present amendments, Applicant has amended independent Claims 20, 22, 24 and 26 to now recite that each of the players of the standard wagering game has the option of also participating in a collateral wagering game, however, a decision by the player to participate in the collateral wagering game would not prevent the player from

receiving a prize amount if the player otherwise had a winning outcome in the standard wagering game. The "option" to participate in the collateral wagering game may, for example, be "exercised" upon payment of an additional wager, though other means for exercising such an option are not excluded from the invention (*see, e.g.*, Claims 22-23, which are not limited to the placement of an "additional wager" by players as a means by which players may exercise their option for participating in the collateral game.)

Applicant has also amended his claims by canceling Claims 16-19, thereby mooting the Examiner's 35 U.S.C. §112, first paragraph, non-enablement rejection and the 35 U.S.C. §102(e) anticipation rejection, which applied Celona, U.S. Patent No. 5,564,700. Applicant understands the Examiner's §102(e) anticipation rejection of Claims 16-19, citing to Celona, as being "tied" to the 35 U.S.C. §112, first paragraph, rejection of these claims – presumably, if Claims 16-19 did not comply with the requirements of 35 U.S.C. §112, first paragraph, then the subject matter of Claims 16-19 was not entitled to the benefit of Applicant's effective filing date of August 27, 1993. Celona carries a filing date of February 10, 1995, and would not otherwise be citable, as Applicant understands the Examiner's 35 U.S.C. §102(e) anticipation rejection, if Claims 16-19 were accorded the benefit of Applicant's August 1993 effective filing date.

As a matter of record, Claims 20-27 have not been rejected as failing to comply with 35 U.S.C. §112, first paragraph, and Applicant respectfully submits that the subject matter of Claims 20-27 is entitled to the benefit of Applicant's effective filing date of August 27, 1993. Applicant's Attorney believes that the Examiner concurs in the under-

signed Attorney's understanding regarding the applicable "prior art" date for pending Claims 20-27.

Turning now, in detail, to an analysis of the Examiner's 35 U.S.C. §102(b) anticipation rejection, as part of the first Office Action, the Examiner has rejected the subject matter of Claims 20-27 as being anticipated by Suttle *et al.*, U.S. Patent No. 4,836,553 (also referred to by the Examiner as Jones *et al.*) It is the Examiner's contention that Suttle *et al.* discloses a method for playing a collateral wagering game (*e.g.*, a bonus game) in combination with a standard wagering game, *i.e.*, poker. According to the Examiner, to play the game in Suttle *et al.*, each player makes a wager in the ante area (14) on an outcome of the poker game with the player also participating in the bonus game (the Examiner citing to Col. 3, lines 8-9 of Suttle *et al.*; it is believed that the Examiner intended to refer to Col. 4, lines 8-9.) The Examiner continues by explaining that, if a player achieves a winning outcome in the poker game, a prize amount, one-to-one odds, is paid to the player. The Examiner further explains that "[e]ach player that wants to continue playing the poker game places an additional wager or bet in the bet area 16," the Examiner citing to Suttle *et al.* at Col. 3, lines 41-45. A prize value to the bonus game is allocated on the basis of the winning outcome in the poker game, with an example of possible payouts provided in Col. 4 of the applied citation, thereby anticipating the invention, according to the Examiner, as originally recited in Claims 20-27.

In reply to the Examiner's anticipation rejection applying Suttle *et al.* (a/k/a "Jones *et al.*"), Suttle *et al.* discloses a poker game, which the Examiner has analogized

to Applicant's "standard game," and a "bonus payment," which has been analogized to Applicant's collateral wagering game and which would appear to be mentioned in Suttle *et al.* at Col. 4, lines 8-9. The "bonus payment," which may be won by a player, would appear to be triggered by the winning poker hand that the player has, as compared to the dealer, and would not appear to require an additional wager, or the exercise of an option by any means, to participate in the "bonus" game, separate and apart from the "standard" poker game.

Applicant's invention, as now recited in independent Claims 20, 22, 24 and 26 states that each player playing the "standard" game has the "option" of playing the "collateral" game (*i.e.*, Applicant's "bonus" game), but need not do so. Unlike Applicant's understanding of Suttle *et al.*, a separate option must be exercised by the player playing the Applicant's standard game to also play the collateral game, while in Suttle *et al.*, the "bonus payment" is automatically available to any player participating in the "standard" poker game.

Further, the Examiner has directed Applicant's attention to Suttle *et al.* at Col. 3, lines 41-45, for the contended disclosure of an "additional wager," which each player may elect to pay to continue playing the poker game disclosed in the applied prior art. Suttle *et al.* states, in relevant part, that:

> "If a player determines that his hand will not beat the dealer's hand, the player folds or drops, i.e., discontinues playing that hand. The dealer wins the player's ante and takes the player's token [initial wager] from the ante area **14** on the playing surface **10** and places it in the chip rack **22**.

> "If the player determines that his hand may beat the dealer's hand, then the player indicates his willingness to continue play by placing a bet in the bet area **16** on the playing surface **10**."

Col. 3, lines 35-43.

While Suttle *et al.* teaches the possibility of making an "additional wager," as the Examiner has correctly noted, the additional wager called for by the applied prior art would appear essential for allowing a player to "continue play" of the standard, or primary, poker game. A player refusing to make the additional wager, discussed by Suttle *et al.*, would automatically concede the poker game to the dealer. Stated differently, if a player refused the requirement of an "additional wager," as taught by the applied citation, then the player no longer has any chance of winning the "standard" poker game.

In sharp contrast to that taught and suggested by Suttle *et al.*, in the presently claimed method for playing a gambling game (as now recited in amended independent Claims 20, 24 and 26; Claim 22 does not require that the "option" for playing the collateral game necessarily be exercised by the placing of an "additional wager"), a player playing Applicant's "standard" game can choose not to make an additional wager for entry into the collateral, or bonus, game, yet still win – and receive a payment for winning – the standard game. This is not possible in the poker game taught by Suttle *et al.*

It is therefore respectfully contended that, because: (1) players of Applicant's standard game have the option of playing Applicant's collateral (or bonus) game, as opposed to being automatically entered into a game having an available "bonus pay-

ment," and (2) the refusal to make the "additional wager" recited in pending Claims 20, 24 and 26 does not result in the player forfeiting any (and all) opportunity to win Applicant's standard game and receive a prize amount for any winning outcome in the standard game, it is respectfully submitted that pending Claims 20-27, as now amended, are neither anticipated by, nor obvious over, the poker game taught and suggested by Suttle *et al.*

Accordingly, withdrawal of the Examiner's 35 U.S.C. §102(b) anticipation rejection of the first Office Action, which applies Suttle *et al.* (a/k/a "Jones *et al.*"), it respectfully contended to be justified.

Finally, the Examiner has rejected the subject matter of Claims 20-27 of the instant patent application on the non-statutory ground of obviousness-type double patenting over Claims 1-27 of Applicant's prior patent, *i.e.*, U.S. Patent No. 5,830,063. In order to overcome the Examiner's obviousness-type double patenting rejection of the first Office Action, Applicant is filing an appropriate Terminal Disclaimer, pursuant to 37 C.F.R. §1.321, and remitting the statutory disclaimer fee of $130.

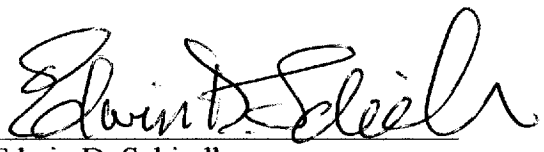
In view of the concurrent-filed Terminal Disclaimer, withdrawal of the obviousness-type double patenting rejection of Claims 20-27 is respectfully requested.

In light of the foregoing, it is respectfully contended that all claims now pending in the above-identified patent application (*i.e.*, Claims 20-27) recite a novel method for playing a gambling game, which is patentably distinguishable over the prior art. Accord-

ingly, withdrawal of the outstanding rejections and the allowance of all claims now pending are respectfully requested and earnestly solicited.

Respectfully submitted,

CHRISTOPHER R. BYRNE

By 
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Enc.: 1. *Terminal Disclaimer to Obviate a Double Patenting Rejection over a "Prior" Patent*; and,

2. EFT for $130.00 (Terminal Disclaimer Fee).

The Commissioner for Patents is hereby authorized to charge the Deposit Account of Applicant's Attorney (*Account No. 19-0450*) for any fees or costs pertaining to the prosecution of the above-identified patent application, but which have not otherwise been provided for.